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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,331	04/01/2004	Ray C. Minor	P69605US0	5342
136	7590	10/31/2005	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			BURCH, MELODY M	
			ART UNIT	PAPER NUMBER
			3683	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/814,331

Applicant(s)

MINOR, RAY C.

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/15/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The amendment filed 8/15/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The originally filed specification lacked support for making such changes as the vertical height being "approximately three (3) inches" instead of "three (3) inches" as amended on pg. 8 of the specification, for example. Also the addition of the phrase "either prior to or after the mounting of half portions 22 and 24 on pole P" on pg. 9 also raises a new issue. Since Applicant has clarified on pg. 7 that the second half portions correspond to the first half portions but have a prime mark, this is sufficient mention of the element numbers in the drawings. Therefore, Examiner recommends deleting the new paragraphs to avoid the new matter issues.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Objections***

2. Claims 33-43 are objected to because of the following informalities: the phrase "inner partial cylinder" in line 6 of claim 33 should be changed to --inner partial cylinder sleeve-- for consistency. Appropriate correction is required. The remaining claims are objected to due to their dependency from claim 33.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification lacks support for the added limitation of the weight receiving chambers being dry as recited in line 3 of claim 44. The remaining claims are rejected due to their dependency from claim 44.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

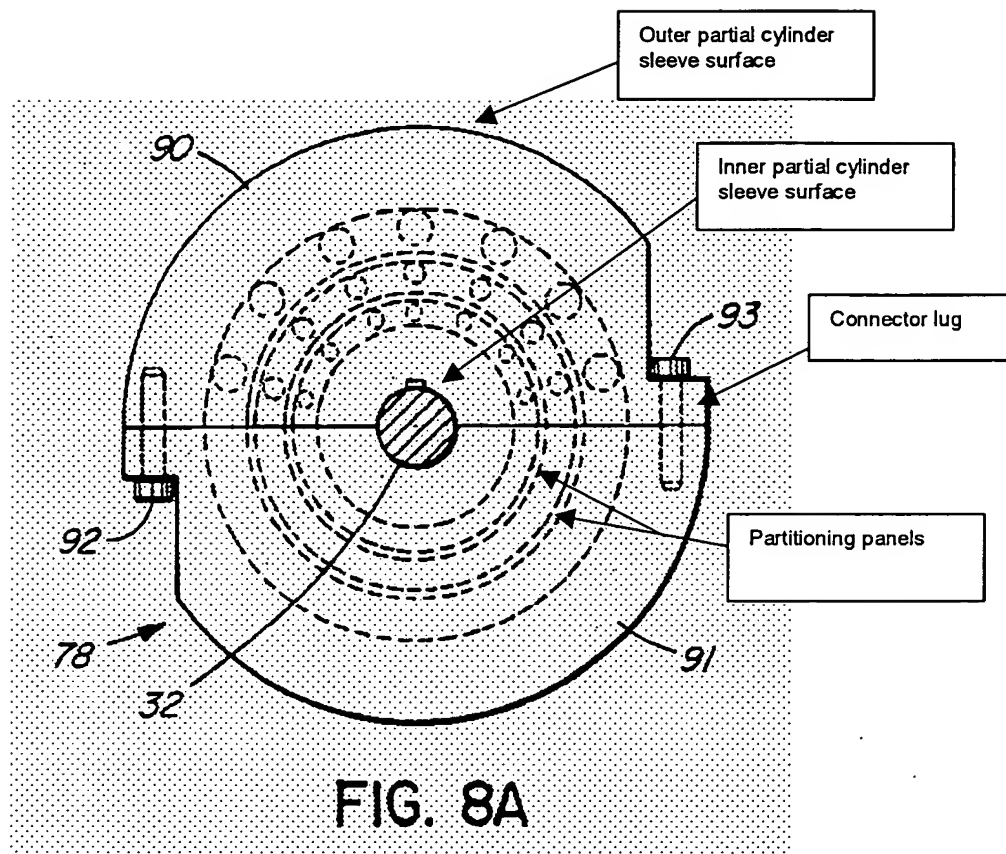
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 33, 34, 44, 45 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5724862 to Hannah et al.

Re: claims 33 and 34. Hannah et al. show in figure 8A pole a vibration damping assembly mountable on a pole 32 capable of damping wind induced first harmonic mode pole vibrations, said assembly comprising an annular housing including a first

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housing component half-portion 90 and a second housing component half-portion 91 and connections 92, 93 connecting the first housing component half-portion to the second housing component half-portion, each housing component half-portion including an inner partial cylinder having an inner partial cylinder sleeve surface as labeled in the drawing on the following page having a lower portion, a center of curvature and being dimensioned and shaped to fit in a mating manner over, and in facing contact with, an upper end portion of a pole having an axis approximately coextensive with the center of curvature of the pole as shown, an outer partial cylinder sleeve positioned outwardly of the inner partial cylinder sleeve surface and having a lower end portion and a center of curvature that is coextensive with the center of curvature of the inner partial cylinder sleeve surface as shown, a floor panel shown below the balls extending between lower portions of the inner partial cylinder sleeve surface and the outer partial cylinder sleeve, a plurality of partitioning panels shown radially between the balls extending vertically upwardly from the floor panel and extending between the inner partial cylinder sleeve and the outer partial cylinder sleeve to define damping weight receiving chambers between adjacent partitioning panels and a movable damping weight or balls in each of the damping weight receiving chambers as shown.



Re: claims 44 and 45. Hannah et al. show in figure 8a a vibration reducing device mountable on a pole 32 capable of damping wind induced first harmonic mode vibrations comprising a housing mountable on a pole and including an annular array of dry weight receiving chambers or annular areas in which the balls are located shaped and dimensioned to encircle and effect mounting of the device on a pole, a damping weight or spherical balls in each dry weight receiving chamber and, wherein, the dry weight receiving chambers are separated by structure or partitioning panels as shown preventing movement of the damping weights from one dry weight receiving chamber to an adjacent dry weight receiving chamber.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 35, 36, 46, and 47 rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah et al.

Hannah et al. are silent with regards to the specific material of the balls. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the balls to have been metal or specifically lead since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

9. Claims 39, 40, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah et al. in view of US Patent 4655317 to Kolya et al.

Re: claims 39 and 48. Hannah et al. describe the invention substantially as set forth above, including the limitation of the damping weights being spherical balls, but are silent as to the damping weights metal balls and being plastic coated.

Kolya et al. teach in col. 3 line 68 - col. 4 line 5 the limitation of a spherical body being coated with plastic.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the spherical balls of Hannah et al., to have been

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coated with plastic, as taught by Kolya et al., in order to provide a means of insulating sound.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the balls to have been metal or specifically lead since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Re: claims 40 and 49. Hannah et al. lack the limitation of the damping weights being metal or that they are coated with polyurethane.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the material of the balls to have been metal since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Kolya et al. teach in col. 3 line 68 - col. 4 line 5 the limitation of a spherical body being coated with polyurethane.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the spherical balls of Hannah et al., to have been coated with polyurethane, as taught by Kolya et al., in order to provide a means of insulating sound.

10. Claims 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hannah et al. in view of US Patent 4711610 to Riehl.



Hannah et al. show in figure 8A wherein the first housing component half-portion and the second housing component half-portion are fixedly connected together to cooperatively encircle the cylindrical pole, each housing component half portion includes a first planar plate extending between a first end portion of the inner partial cylinder sleeve and a connector lug labeled in the labeled version of figure 8A found earlier in the office action comprising part of the connection on a first end portion of the outer partial cylinder sleeve, and a second planar panel extending between a second end portion of the inner partial cylinder sleeve and a connector lug as labeled comprising part of the connection on a second end portion of the outer partial cylinder sleeve and threaded screws comprising part of the connection connecting the connector lug of the second housing component half portion to provide a rigid housing structure.

Hannah et al. lack the limitation of the planar plates.

Riehl teach in figures 1 and 5A the use of circular or arcuate chambers 118 housing damping weights 116 with the chambers including a first and second planar plate shown at the end of the respective element numbers 122. Examiner notes that the ends of the arcuate segments that hold the damping weights within the chamber are planar as shown in figures 1 and 5A.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the completely annular chambers of Hannah et al. to have been divided into arcuate pockets with pocket ends

comprising first and second planar plates, as taught by Riehl, in order to provide a means of adjusting the sensitivity of the damping function of the device.

Hannah et al. lack the limitation of the screws and the damping weights being specifically made of metal or the damping weights being made of lead.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the material of the screws and damping weights to have been metal or in the case of the damping weights to have been lead since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 571-272-7114. The examiner can normally be reached on Monday-Friday (6:30 AM-3:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on 571-272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*mmb*  
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October 19, 2005

*Melody M. Burch*  
10/19/05

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10-27-05